



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,304	04/27/2001	Phillip Clark	MCA-500 US	1202

25182 7590 11/19/2003

MILLIPORE CORPORATION
290 CONCORD ROAD
BILLERICA, MA 01821

EXAMINER

MENON, KRISHNAN S

ART UNIT PAPER NUMBER

1723

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,304

Applicant(s)

CLARK ET AL.

Examiner

Krishnan S Menon

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7,16,17 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-26 is/are allowed.
- 6) ☒ Claim(s) 1,2,7,16,17 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 1,2,7,16,17 and 24-29 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1,2 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wolf et al (US 5,462,874).

Wolf discloses a multi-well filter plate (abstract) with a membrane in a sheet form (20), membrane being an ultrafiltration membrane, adhesively bonded to the bottom of the well plate (10 – see figures; col 12 lines 20-30; col 12 line 64 – col 13 line 10) as in the instant claims. Flow through the membrane depend on pressure differential as in claim 1 (see col 10 lines 60-66).

2. Claims 1 and 16 are rejected under 35 U.S.C. 102(a/e) as being clearly anticipated by Mathus (US 5,972,694).

Mathus teaches a multiwell plate with a membrane (42) (figures) in a sheet-form (col 3 lines 45-52) adhesively attached to the bottom of the well plate (20 – fig 8; col 6 lines 29-40) as in claim 1, the membrane being a microfiltration membrane as in claim 16 (abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf (874)

Wolf teaches a multi-well filter plate as recited in claim 27, except for the specific count of the 384-wells. Having 384 wells is only mere replications of ‘plurality of wells’ of Wolf. (Note: mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v Benis Co.*). Re claim 28 (see col 12 lines 20-30) wherein the ultrafiltration membrane is adhered to the well bottom form the first (top) surface having smaller pores, see Wolf (col 12 lines 20-34), the membrane is described as ‘skinned membranes’ cast on top of a matrix material, which means that the top (first, skin) surface of the membrane has smaller pores, bottom (backing) has larger pores.

4. Claims 7 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf et al (874) in view of Dubrow et al (US 6,251,343 B1).

Wolf teaches all the limitations of claims 7 and 29 as in claim 1 above, except for the type of adhesive being used. Dubrow teaches attachment of a membrane on the underside of a multiwell plate (cover in this instance – see col 9 lines 13-24 in view of col 12 lines 28-40) using adhesives, which are “well known”, and teaches UV curing adhesive as an example. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Dubrow, being well known, in the teaching of Wolf for the multi-well plate.

Allowable Subject Matter

Claims 24-26 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art for the instant claim(s) is Matkovich et al (US 4,797,259). Matkovich does not teach forming troughs to contain the adhesive in the well bottom surface, or providing cuts in the membrane to seal through the membrane to prevent cross talk as in the instant claim(s). These improvements are deemed not obvious to one of ordinary skill in the art.

Response to Arguments

Applicant's arguments with respect to claims 1,2,7,16,17 and 27-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.

Application/Control Number: 09/844,304

Page 5

Art Unit: 1723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Krishnan Menon
Patent Examiner


W. L. WALKER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700